

Agilent Dkt. No.: 10010760-1

REMARKS

In view of the following remarks, the Examiner is respectfully requested to withdraw the rejections and allow Claims 13, 15 - 16 and 18 to 23, as well as newly added Claims 28-34, the only claims pending and currently under examination in this application.

Claims 28-34 are added by the above amendment. Claim 28 finds support in Claim 13, 18 and 23. Claims 29 -34 find support in Claims 15-26 and 19-22. As these claims introduce no new matter, their entry by the Examiner is respectfully requested.

The Examiner continues to object to the specification on the grounds that documents have been improperly incorporated by reference. The Examiner objects to the language at paragraph 36 of page 8 relating to relating to the incorporation by reference of all patents, patent applications and publications mentioned in the application. The Examiner asserts that the language "fails to specify what specific information applicant seeks to incorporate by reference and similarly fails to teach with detailed particularity just where that specific information is to be found in each of the cited references."

In maintaining this objection, the Examiner relies on *Ex parte Raible*, 8 U.S.P.Q.2d 1707 (BPAI, 1998).

However, *Ex parte Raible* does not stand for the position that an objection should be raised to a specification for including the language questioned by the Examiner in making this objection. Instead, *Ex parte Raible* holds that where a particular element of claim is only supported in a document incorporated by reference into the specification, the portion of the incorporated document that is asserted to support the claim element needs to be identified.

In the present case, all of the elements of the claims are fully supported by the specification as filed, and no question has been raised that any of the elements need to be supported by any teaching that is not actually in the specification but only in a document that has been incorporated into the specification by reference.

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As such, the facts of the present application are clearly distinguishable from those of *Ex parte Raible*. Furthermore, the holding of *Ex parte Raible* does not mean that an objection should be raised to any specification which includes the phrase questioned by the Examiner in making the present objection.

Accordingly, the Applicants submit that the documents cited in the instant application are properly incorporated by reference in their entireties. As such, the Applicants respectfully request the objection to the specification be withdrawn.

Next, Claims 13 and 15-16 and 18-23 have been rejected under 35 U.S.C. § 112, first paragraph as assertedly failing to comply with the written description requirement.

It is believed that this rejection is based on the Examiner's inaccurate reading of Claim 13 as requiring that the background features not bind at all to complementary nucleic acids under stringent conditions.

However, Claim 13 reads in part as follows:

at least one background feature, wherein said background feature is a polymeric composition that comprises background probes that **do not specifically bind** under stringent hybridization conditions to complementary nucleic acids in said sample...[emphasis added]

As such, what is claimed is that the background features do not specifically bind to complementary nucleic acids. The claim does not require that no binding occur— just that no **specific** binding occur.

As such, what is claimed is that the background probe not specifically bind to its complementary nucleic acid. This subject matter is extensively described in the specification and numerous specific embodiments of different sequences demonstrated to work as such background features are provided in the Experimental Section.

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As such, one of skill in the art would not doubt that, at the time the application was filed, the inventors were in possession of the claimed invention that only requires the background probes to not specifically bind to complementary nucleic acids.

Accordingly, Claims 13, 15-16 and 18-23 do comply with the written description requirement under 35 U.S.C. § 112, first paragraph and this rejection may be withdrawn.

Finally, with respect to newly added Claims 28-34, these claims are allowable in their present form for at least the reasons provided above.

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CONCLUSION

In view of the above amendments and remarks, this application is considered to be in good and proper form for allowance and the Examiner is respectfully requested to pass this application to issue.

The Commissioner is hereby authorized to charge any underpayment of fees associated with this communication, including any necessary fees for extensions of time, or credit any overpayment to Deposit Account No. 50-1078.

Respectfully submitted,

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